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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/325,536	06/04/1999	KEVIN BOYLE	47004.000040	2934

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HUNTON & WILLIAMS
INTELLECTUAL PROPERTY DEPARTMENT
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SUITE 1200
WASHINGTON, DC 20006-1109

EXAMINER

THOMPSON JR, FOREST

ART UNIT	PAPER NUMBER
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2165

DATE MAILED: 03/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/325,536

Applicant(s)

BOYLE ET AL. *WJ*

Examiner

Forest O. Thompson Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action (See Paper No. 5). The text of those sections of Title 35, U.S. Code not otherwise provided in a prior Office action will be included in this action where appropriate.

2. This action is responsive to the amendment (amendment A) filed 22 December 2000 (see Paper #9). Amendment A amended claims 8, 13, 16-17, 21, and 25. **Claims 1-25 are pending.**

3. **Claims 1-25 have been examined.**

Drawings

4. The drawings received on 04 June 1999 are objected to by the Draftsperson (see form PTO 948).

Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect can be deferred until the application is allowed by the examiner.

Claim Objections

5. Claim 25 was objected to in Paper #5 because of the following informalities: the claim stated "said club merchant or service provider" on pg. 24 in line 18. Claim 25 is dependent from

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independent claim 21 which stated "a plurality of clubs, merchants or service-providers" on pg. 24 in lines 2-3, and dependent claim 23 which stated "said plurality of clubs, merchants or service-providers" on pg. 24 in lines 14-15. Proper antecedent basis for the term in claim 25 was not provided nor identified by applicant. Applicant's amendment overcomes these objections; therefore, examiner withdraws the objections.

Claim Rejections - 35 USC § 102

6. Claim 13 is rejected under 35 U.S.C. 102(e) as being anticipated by **Kolling et al.** (U.S. Patent No. 5,920,847).

Claim 13: **Kolling et al.** discloses:

- a server for receiving applications, processing point of sale transactions and processing auto-charges to clubs, merchants or service-providers (col. 11 lines 5-33; fig. 18A [1802-1807]);
- a plurality of user systems for submitting applications (fig. 14 [502a-c]); and
- a network interfacing said server and said plurality of user systems (col. 11 lines 5-33).

Claim Rejections - 35 USC § 103

7. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Fernandez-Holmann** (U.S. Patent No. 5,787,404), and further in view of **Carlisle et al.** (U.S. Patent No. 5,649,118), **Pollin** (U.S. Patent No. 6,041,315), and **Perazza** (U.S. Patent No. 5,326,959).

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8. **Note:** In this invention, applicant claims said credit card having encoded information thereon that associates the cardholder with a plurality of clubs, merchants or service providers for which automated charges can be effectuated. Examiner maintains that the plurality of clubs, merchants or service providers for which automated charges can be effectuated are consistent with any service providers or entities (including the funding of an investment account at a service provider) that may be associated with a cardholder through encoded information on the credit card, including merely an account number on the credit card that is correlated by the credit card issuer with the credit card number and associated data in the credit card issuer's database, and add no patentable weight to applicant's claim. The functionality for this association exists in most databases through their inferred capabilities as databases. Databases provide the functionality to store, sort and correlate data based on user guidelines. Databases also allow multiple cross references or cross-correlations for similar or related data. Also, specific claim limitations to "the plurality of clubs, merchants or service providers for which automated charges can be effectuated" do not change or prevent this inference.

9. Claim 1: **Fernandez-Holmann** discloses:

- a credit card capable of charging point of service transactions (col. 2 lines 24-44); and
- said credit card having encoded information thereon (col. 2 lines 24-44);

Fernandez-Holmann discloses a method and system for providing an investment fund, such as a long term investment fund which may be suitable for retirement purposes, comprising

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the steps of establishing a credit based account with a credit card issuer for the benefit of a credit card holder, providing an investment account with a financial institution for the benefit of the credit card holder, funding the investment account by the credit card issuer with a predetermined amount of money on a periodic basis, and charging an amount of money so funded against the credit based account of the credit card holder (Abstract). **Fernandez-Holmann** does not specifically disclose said credit card having encoded information thereon that associates the cardholder with a plurality of clubs, merchants or service providers for which automated charges can be effectuated. However, one inherent feature of credit cards is an identifier encoded on the card to provide identification of the user account to be charged for transactions. Additionally, **Carlisle et al.** does disclose systems and methods are disclosed wherein a single set of consumer items may be purchased by debiting any of a plurality of accounts stored on a smart card (col. 1 lines 65-67). Additionally, **Perazza** discloses:

funds can automatically and promptly be transferred, together with appropriate customer identifying information, to each biller's designated bank and its application, using conventional clearinghouse systems (Abstract);

- preauthorized payment instructions for bill payments which are regular and fixed (col. 3 lines 9-17); and
- "Preauthorized Payment" means a system whereby a Bill Payer gives the Biller written authorization and instructions to allow the Biller, through its bank, to routinely (usually monthly)

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automatically deduct predetermined sums from a Bill Payer's account for the credit of the Biller through ACH (col. 2 lines 27-33).

- The bank has stored, in computer memory, the names and other identifying information regarding the billers for each customer (Abstract).

Additionally, **Pollin** discloses the system verifies the bank and account information by comparing the input information to records in a database associated with the system (Abstract).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify **Fernandez-Holmann** to disclose said credit card having encoded information thereon that associates the cardholder with a plurality of clubs, merchants or service providers for which automated charges can be effectuated, as disclosed through the functionality of **Carlisle**, **Pollin** and **Perazza**, because this provides capabilities that facilitate the user's payment process and ease the burden on the user of making periodic payments.

Claim 2: **Fernandez-Holmann** discloses said encoded information is of an account number that is correlated by a credit card processing system to said plurality (col. 2 lines 24-44), .

Claim 3: **Fernandez-Holmann** disclose said cardholder's account is automatically updated to reflect said automated charges by said credit card processing system (col. 2 lines 24-44; col. 4 lines 9-34).

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Claim 4: **Fernandez-Holmann** does not disclose encoded information thereon identifies one or more said plurality for use as an admission pass. However, Official Notice is taken that use of a credit card or other card as an admission pass was old and well known at the time the invention was made. One example is the use of an ATM card at a bank to open the door to access the area where an ATM is located. It would have been obvious to one skilled in the art to combine **Fernandez-Holmann** and old and well known art to disclose encoded information thereon identifies one or more said plurality for use as an admission pass, because this is a desirable security/access control feature for businesses and merchants.

10. Claims 5-12 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Fernandez-Holmann** (U.S. Patent No. 5,787,404), and further in view of **Reeder** (U.S. Patent No. 6,014,636), and **Kolling et al.** (U.S. Patent No. 5,920,847).

Claim 5: **Fernandez-Holmann** discloses:

- a server adapted to interface with user systems for receiving applications and batch processing auto-charge transactions; (col. 2 lines 27-38), through establishing a credit based account with a credit card issuer for the benefit of a credit card holder, providing an investment account with a financial institution for the benefit of the credit card holder, funding the investment account by the credit card issuer with a predetermined amount of money on a periodic basis, and charging an amount of money so funded against the credit based account of the credit card holder,

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all of which support the functionality of a server as part or component of the **Fernandez-Holmann** invention;

- a monetary processor system for processing point of sale transactions submitted over an interchange (col. 3 lines 19-21), by automatically making the required periodic payments to the investment account and billing the consumer accordingly along with the purchase charges normally incurred by the consumer; and
- the credit card holder may be billed by the credit card issuer for the amount of money funded to the investment account (col. 2 lines 45-47), by automatically making the required periodic payments to the investment account and billing the consumer accordingly along with the purchase charges normally incurred by the consumer.

Fernandez-Holmann does not specifically disclose a database containing a plurality of cardholders. **Fernandez-Holmann** does disclose establishing a credit based account with a credit card issuer for the benefit of a credit card holder, and providing an investment account with a financial institution for the benefit of the credit card holder (col. 2 lines 27-38). These are actions associated with and necessary for the functionality of creating and using a database, and infer a database containing a plurality of credit card holders.

Additionally, **Reeder** discloses a method for providing point-of-sale (POS) payment using interactive television (ITV) or the world wide web (WWW) by directly debiting a customer's bank account through electronic transfer of funds or by billing a customer's credit card account (Abstract).

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Neither **Fernandez-Holmann** nor **Reeder** specifically disclose a dues processor system for processing batch files of auto-charges. **Fernandez-Holmann** does disclose:

- automatically making the required periodic payments to the investment account and billing the consumer accordingly along with the purchase charges normally incurred by the consumer (col. 3 lines 19-21); and
- A fee such as a service charge or interest may be charged against the credit based account of the credit card holder when the credit card issuer funds the investment account in any given period (col. 2 lines 41-44), which encompasses the functionality of a dues processor.

Additionally, **Kolling et al.** disclose batch processing auto-charge transactions (col. 11 lines 5-33; col. 37 lines 9-17). Therefore, it would have been obvious to one skilled in the art to modify **Fernandez-Holmann** to disclose a server adapted to interface with user systems for receiving applications and batch processing auto-charge transactions; a monetary processor system for processing point of sale transactions submitted over an interchange; a dues processor system for processing batch files of auto-charges; and a database containing a plurality of cardholders, as disclosed by **Reeder** and **Kolling et al.**, because this provides obvious benefits in the scope of the invention to provide customer satisfaction for the transactions that a customer initiates.

Claim 6: **Fernandez-Holmann** discloses a report processor system for generating reports of account activity (col. 3 lines 11-21).

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Claim 7: **Fernandez-Holmann** discloses a transaction processor for accessing said database to determine if a transaction request is to be authorized (col. 5 lines 3-35).

Claims 8-12: **Fernandez-Holmann** does not disclose said database further contains information identifying a partner that is associated with a plurality of clubs, merchants, or service-providers; said partner is a branch of the military, said partner is a university or college; said database contains information identifying one or more installations or bases of said partner; said database is a fully relational database allowing a cardholder to be transferred from one installation or base to another installation or base. Official Notice is taken that it was old and well known in the art at the time the invention was made that organizations may be associated with a plurality of clubs, merchants, or service providers for business or other purposes. One example of this are the gas stations located on military installations. Additionally, Official Notice is taken that it was old and well known in the art at the time the invention was made that users of credit accounts or other types of accounts may relocate from time to time and still be able to use the credit instruments previously used, while providing update information as to the user's status and location/address. This is a common procedure for credit card users who may change their residence due to employment or other reasons. Additionally, credit card users who travel may still use their credit cards while away from the area of their primary residence. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify **Fernandez-Holmann** to disclose said database further contains information identifying a partner that is associated with a

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plurality of clubs, merchants, or service providers, said partner is a branch of the military, said partner is a university or college, said database contains information identifying one or more installations or bases of said partner, nor said database is a fully relational database allowing a cardholder to be transferred from one installation or base to another installation or base, as disclosed by **Kolling et al.**, **Reeder**, and old and well known art, because this provides desirable utility to the invention and increases the population of users that may be interested in using the invention.

Claim 17: **Fernandez-Holmann** discloses providing a credit card processing system having a database of cardholder account data, including in said database information of a plurality of clubs, merchants or service providers agreeing to auto-charging of dues or fees, and entering data in said database for an applicant or cardholder of one or more clubs, merchants or service providers which are to be issued funds automatically through the functionality of:

- through establishing a credit based account with a credit card issuer for the benefit of a credit card holder, providing an investment account with a financial institution for the benefit of the credit card holder, funding the investment account by the credit card issuer with a predetermined amount of money on a periodic basis, and charging an amount of money so funded against the credit based account of the credit card holder, all of which support the functionality of a server as part or component of the **Fernandez-Holmann** invention (col. 2 lines 27-38);

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- automatically making the required periodic payments to the investment account and billing the consumer accordingly along with the purchase charges normally incurred by the consumer (col. 3 lines 19-21); and
- automatically making the required periodic payments to the investment account and billing the consumer accordingly along with the purchase charges normally incurred by the consumer (col. 2 lines 45-47).

Claim 18: **Fernandez-Holmann** discloses said step of entering data includes entry of information describing at least one of the frequency and date of the funds to be issued (col. 2 lines 23-44).

Claim 19: **Fernandez-Holmann** discloses said step of entering data includes entry of information describing the amount of funds to be issued (col. 2 lines 23-44).

Claim 20: **Fernandez-Holmann** discloses the step of processing a plurality of transaction requests based on said data (col. 4 lines 9-34).

11. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kolling et al.** (U.S. Patent No. 5,920,847) as applied to claim above, and further in view of **Fernandez-**

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Holmann (U.S. Patent No. 5,787,404), **Carlisle et al.** (U.S. Patent No. 5,649,118), and **Perazza** (U.S. Patent No. 5,326,959).

Claim 21: **Kolling et al.** disclose:

- periodically searching the database to identify a plurality of cardholders who are to be charged a fee or due (col. 11 lines 5-33), through the activities associated with identifying billers, setting communications protocols, data pointers pointing to data elements to be associated with account processing;
 - generating a batch of transaction requests based on said step of searching (col. 36 lines 31-67; col. 37 lines 1-16);
 - submitting said batch to a transaction processor (col. 36 lines 31-67; col. 37 lines 1-16);
- and
- updating the accounts of said plurality of cardholders based on results reported by said transaction processor (col. 37 lines 27-30).

Additionally, **Fernandez-Holmann** discloses:

- a credit card capable of charging point of service transactions (col. 2 lines 24-44); and
- said credit card having encoded information thereon (col. 2 lines 24-44);

Fernandez-Holmann also discloses a method and system for providing an investment fund, such as a long term investment fund which may be suitable for retirement purposes, comprising the steps of establishing a credit based account with a credit card issuer for the benefit

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of a credit card holder, providing an investment account with a financial institution for the benefit of the credit card holder, funding the investment account by the credit card issuer with a predetermined amount of money on a periodic basis, and charging an amount of money so funded against the credit based account of the credit card holder (Abstract). **Fernandez-Holmann** does not specifically disclose said credit card having encoded information thereon that associates the cardholder with a plurality of clubs, merchants or service providers for which automated charges can be effectuated. However, one inherent feature of credit cards is an identifier encoded on the card to provide identification of the user account to be charged for transactions. Additionally, **Carlisle et al.** does disclose systems and methods are disclosed wherein a single set of consumer items may be purchased by debiting any of a plurality of accounts stored on a smart card (col. 1 lines 65-67). Additionally, **Perazza** discloses:

funds can automatically and promptly be transferred, together with appropriate customer identifying information, to each biller's designated bank and its application, using conventional clearinghouse systems (Abstract);

- preauthorized payment instructions for bill payments which are regular and fixed (col. 3 lines 9-17); and
- "Preauthorized Payment" means a system whereby a Bill Payer gives the Biller written authorization and instructions to allow the Biller, through its bank, to routinely (usually monthly) automatically deduct predetermined sums from a Bill Payer's account for the credit of the Biller through ACH (col. 2 lines 27-33).

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- The bank has stored, in computer memory, the names and other identifying information regarding the billers for each customer (Abstract).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify **Kolling et al.** to disclose said credit card having encoded information thereon that associates the cardholder with a plurality of clubs, merchants or service providers for which automated charges can be effectuated, as disclosed through the functionality of **Carlisle, Fernandez-Holmann** and **Perazza**, because this provides capabilities that facilitate the user's payment process and ease the burden on the user of making periodic payments.

Claim 22: **Kolling et al.** disclose automatically transferring funds to a club, merchant or service provider based on said results (col. 36 lines 31-67; col. 37 lines 1-30).

Claim 23: Claim 23 is written as a method and contains the same limitations as claim 22; therefore, the same rejection is applied.

12. Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kolling et al.** (U.S. Patent No. 5,920,847).

Claim 14s and 15: **Kolling et al.** does not disclose at least one of said user systems is located at a military base, nor at least one of said user systems is located at a university or college.

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However, Official Notice is taken that the location of the user system is not a necessary parameter in the use of the invention (outside the art), nor does it necessarily enhance or restrict the use of the invention. Therefore, it would have been obvious to one skilled in the art at the time the invention was made that at least one of the user systems could be located at a military base or a university or college, or anywhere appropriate/necessary network connectivity may be achieved to provide the desired level of service to the user. Such connectivity is restricted only by limitations on connectivity to appropriate network connectivity access points. It would have been obvious to one skilled in the art at the time the invention was made to modify **Kolling et al.** To disclose at least one of said user systems is located at a military base, or at least one of said user systems is located at a university or college, as disclosed by obvious and old and well known potential connectivity capabilities, since the invention may be used practically anywhere a computer may be interconnected to the appropriate network and be operated.

13. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Kolling et al.** (U.S. Patent No. 5,920,847), and further in view of **Fernandez-Holmann** (U.S. Patent No. 5,787,404).

Claim 16: **Kolling et al.** discloses participating consumers pay bills to participating billers (col. 11 lines 5-33). including information of charges to be automatically posted to cardholder

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accounts and credited to a club, merchant or service-provider. However, **Fernandez-Holmann** discloses:

- the system and methods of the preferred embodiment of the present invention described and claimed may be carried out by any of various computer based systems known in the prior art and programmed according the methodologies described herein in order to carry out the desired functions (col. 7 lines 31-36), and
- the credit card issuer automatically makes the required periodic payments to the investment account and bills the consumer accordingly along with the purchase charges normally incurred by the consumer (col. 3 lines 17-21).

Also, Official Notice is taken that databases are old and well known in the art and are common to banks and credit card companies. They provide necessary functionality for the efficient and quick electronic storage and manipulation of data. Therefore, it would have been obvious to one skilled in the art to modify the invention of **Kolling et al.** to disclose a database of cardholders including information of charges to be automatically posted to cardholder accounts and credited to a club, merchant or service provider, as disclosed by **Fernandez-Holmann** and old and well known art, because a database is common to most computer applications that must repetitively process large amounts of data, as in monthly bill and payment processing for credit cards.

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14. Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kolling et al.** (U.S. Patent No. 5,920,847).

Claims 24 and 25: **Kolling** does not disclose said club, merchant or service provider is located on a military base or installation. **Kolling** does disclose it is possible that service providers will provide services to a consumer regardless of the location of the consumer's account and that banks will accept payment authorization requests from any service providers (col. 32 lines 17-29). Additionally, the location of said club, merchant or service provider as defined in applicant's invention is not a necessary parameter in the use of the invention (outside the art), nor does it necessarily enhance or restrict the use of the invention.

Response to Arguments

15. Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Forest Thompson whose telephone number is (703) 306-5449. The examiner can normally be reached Monday-Friday from 7:00 AM to 3:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached at (703) 308-1344.

The fax numbers for the organization are as follows:


After Final: (703) 746-7238

Official: (703) 746-7239

Non-Official/Draft: (703) 746-7240

Any inquiry of a general nature or relating to the application or processing should be directed to the receptionist whose telephone number is (703) 305-3900.

March 21, 2002 /FOT


WYNN COGGINS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100